

**REMARKS**

**I. Summary of Office Action**

Claims 11, 13, 14, 16, 22, 23, 28, and 29 were pending in the application.

Claim 23 has been rejected under 35 U.S.C. § 101.

Claims 11, 13, 14, 16, 22, 23, 28, and 29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over EasyLink in view of United States Patent No. 4,580,012 to Matthews et al. (hereinafter, "Matthews").

**II. Summary of Applicants' Response**

Applicants have amended claims 22, 23, and 28.

Applicants have canceled claims 11-16 and 29 without prejudice.

Applicants have added new claims 30-43.

The Examiner's rejections of claims 22, 23, and 28 are respectfully traversed.

Reconsideration of the application is respectfully requested.

**III. The Rejection of Dependent Claim 23 Under 35 U.S.C. § 101**

In rejecting claim 23, the Examiner stated, in reference to claims 22 and 23, that the "claimed invention will not produce useful and concrete results because the declaration identifier may not be the same identifier." (Office Action, page 2). Applicants have amended claim 23. Applicants submit that it is now clear that the declaration identifier communicated from "the relying party to the affirming party prior to receiving the declaration identifier at the recording system," in amended claim 23 is the same declaration identifier received at the recording system from the relying party and the affirming party in claim 22. Accordingly, Applicants respectfully submit that the amendments to claim 23 overcome the rejection under 35 U.S.C. § 101 and respectfully request withdrawal of this rejection.

**IV. The Rejections of Independent Claims 22 and 28 Under 35 U.S.C. § 103(a)**

Independent claim 22 relates to a method for recording a solemn declaration. For example, claim 22 recites receiving a transaction identifier from a relying party at a recording

system that identifies a transaction requiring a declaration, receiving and recording a voice message from an affirming party which includes the required declaration thereby completing the transaction, associating a recording identifier with the voice message, and in response to the completion of the transaction, communicating the transaction identifier and the recording identifier to the relying party and communicating the recording identifier to the affirming party. Accordingly, both the relying party and the affirming party are provided with a way to refer to the same transaction by using the transaction identifier and are both provided with a recording identifier that can be used to access the recorded voice message, which provides evidence the transaction was completed. Furthermore, claim 22 recites a method that automatically alerts the relying party that the transaction is completed (e.g., "in response to the indication"). In contrast to claim 22, EasyLink, as far as Applicants can determine from the limited information provided by the Examiner, merely teaches a system which is capable of recording consent to a transaction. Matthews merely teaches a voice mail system. No combination of EasyLink and Matthews teach or suggest the combination of elements recited in claim 22. For example, amended claim 22 includes:

- (a) receiving a transaction identifier at a recording system from a relying party via a first communications network, the transaction identifier identifying a transaction requiring a declaration from an affirming party;

- (b) associating the transaction identifier with the relying party at the recording system;

- (c) subsequently, receiving the transaction identifier at the recording system from the affirming party via a second communications network;

- (d) receiving a voice message at the recording system from the affirming party via a second communications network, the voice message including a statement of the declaration required from the affirming party, thereby providing an indication of the completion of the transaction;

- (e) recording and storing the voice message at the recording system;

- (f) associating a recording identifier with the recorded voice message;

- (g) communicating the transaction identifier together with the recording identifier to the relying party via a third communications network in response to the indication of completion of the transaction; and

- (h) communicating the recording identifier to the affirming party via a fourth

communications network in response to the indication of the completion of the transaction.

#### **A. Communication of the Transaction Identifier**

Among other things, claim 22 recites a “transaction identifier identifying a transaction requiring a declaration from an affirming party” being exchanged among three parties (a relying party, an affirming party, and a recording system). Element “a” of claim 22 recites a recording system receiving a transaction identifier from the relying party. Element “c” recites the recording system receiving the transaction identifier from the affirming party. Element “g” recites the recording system communicating the transaction identifier back to the relying party. Neither Easylink nor Matthews alone or in combination teach or suggest a transaction identifier being exchanged between a relying party, an affirming party, and recording system, let alone being exchanged as recited in elements “a,” “c,” and “g.” Instead, as best as Applicants can discern from the limited information describing EasyLink the Examiner has presented, EasyLink merely shows various messages that make up a part of a transaction but are not related by a transaction identifier, let alone a transaction identifier that is exchanged among three parties as claimed.

Matthews is similarly deficient as it does not teach or suggest a series of related messages identified by a transaction identifier identifying a transaction requiring a declaration from an affirming party, let alone, a transaction identifier that is exchanged among three parties as claimed. For example, nothing in EasyLink and Matthews teaches or suggests a recording system receiving a transaction identifier (as recited in element “a”), receiving that same transaction identifier from an affirming party (as recited in element “c”), and then communicating the transaction identifier back to the affirming party (as recited in element “g”).

#### **B. Association of the Transaction Identifier**

Element “b” recites “associating the transaction identifier with the relying party at the recording system.” Applicants submit that neither EasyLink nor Matthews teach or suggest such an element. For example, assuming *arguendo* that the party sending the message illustrated on page 1 of EasyLink is the relying party; the message on that page merely illustrates that a relying party agrees to a set of terms for the purchase of their home. However, nothing on that page, nor anywhere else in EasyLink, teaches or suggests that the EasyLink system has associated a transaction identifier with the relying party. Furthermore, nothing teaches or suggests that

EasyLink has associated a transaction identifier with the relying party that was received from the relying party (as recited in element “a”).

Nor does anything in Matthews teach or suggest a transaction identifier being received from a relying party and then associated with that relying party. While Matthews suggests a number being related to an individual or to a voice mail box (e.g., a phone number), Applicants submit that any such number does not identify a transaction as recited in claim 22.

### **C. Presence of a Transaction Identifier**

EasyLink does not even appear to teach or suggest a transaction identifier at all. EasyLink merely identifies the parties of a transaction -- it does not provide identifiers that identify the transaction itself as recited in claim 22. Applicants respectfully request that, if the application is not allowed, any further Office Action issued comply with 37 CFR § 1.104(c), that “the particular part [of the reference] relied on must be designated as nearly as practicable.” While the present Office Action states that “EasyLink teaches ... a transaction identifier corresponding to the transaction,” it does not provide an indication of what in EasyLink the Examiner believes to correspond to a transaction identifier. The Applicants request that they be notified of “the reasons for such rejection, or objection, or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution.” (35 U.S.C. §132).

### **D. In Response to the Indication of Completion of the Transaction**

Element “d” recites “receiving a voice message ... including a statement of the declaration ... thereby providing an indication of the completion of the transaction.” Elements “g” and “h” each recite communicating “in response to the indication of completion of the transaction.” Neither EasyLink nor Matthews alone or in combination teach or suggest such a combination of elements. Instead, it appears that EasyLink allows a party to receive a message sent by another or, at most, alerts a party that a message has been received (though it cannot be determined whether Easylink teaches or suggests alerting at all based on the three screen shots provided to the Applicants by the Examiner). However, nothing in EasyLink teaches or suggests, for example, “communicating the transaction ... to the relying party ... in response to the indication of completion of the transaction.” As a voice messaging system, Matthews may teach or suggest alerting a party that a message has been received in response to a message being

received. However, Matthews, neither alone nor in combination with EasyLink, teaches or suggests alerting a party of anything “in response to the indication of completion of the transaction.” Furthermore, no combination of EasyLink and Matthews teaches or suggests “communicating the transaction identifier together with the recording identifier ... in response to the indication of completion of the transaction” as recited by element “g.”

For at least the above reasons, claim 22 is believed to be patentable over EasyLink in view of Matthews. Claim 28 recites similar elements as those discussed above with respect to independent claim 22. Accordingly, Applicants respectfully request that the rejection of claims 22 and 28 under 35 U.S.C. § 103(a) be withdrawn.

In addition, Applicants submit that claim 23, which depends from claim 22, is allowable for at least the same reasons that independent claim 22 is allowable. Therefore, Applicants respectfully request that the Examiner withdraw the rejection to claim 23.

#### **V. New Claims 30-43**

Applicants have added new claims 30-43. Support for claims 30-43 can be found throughout the specification. Each of claims 30-43 depends from one of claims 22 and 28 is allowable for at least the same reasons that independent claims 22 and 28 are allowable. Applicants respectfully request such allowance.

**CONCLUSION**

Applicants respectfully submit that, as described above, the cited reference does not show or suggest the combination of features recited in the claims.

Any amendments made to the claims in the present Reply are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather, these amendments are merely Applicants' attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

For at least the reasons set forth above, Applicants respectfully submit that this application is in condition for allowance. Reconsideration and prompt allowance of the application are respectfully requested.

**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment, to Deposit Account No. 08-0219

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 08-0219.

Respectfully submitted,

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